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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/822,770

04/13/2004

Hiroataka Fukushima

05266.0062

2884

7590

12/02/2004

Finnegan, Henderson, Farabow,
Garrett & Dunner, L.L.P.
1300 I Street, N.W.
Washington, DC 20005-3315

EXAMINER

HARVEY, JAMES R

ART UNIT

PAPER NUMBER

2833

DATE MAILED: 12/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/822,770

Applicant(s)

FUKUSHIMA ET AL.

Examiner

James R. Harvey

Art Unit

2833

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 4-13-04 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4-13-04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

- The Information Disclosure statement(s) and related documents that were filed on 4-13-04 have been considered.

Priority

- Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Objections

- Claim(s) 1-7 are objected to because of the following informalities:
 - In reference to Claim(s) 1, the recitation "packing is divided into two segments" is vague. The word "divided" implies there is more than one piece (see attached definition from The American Heritage Dictionary). Applicant is reminded that the claims should particularly point out and distinctly claim the subject matter which the applicant regards as his invention so that the public clearly knows the meets and bounds of applicant's claimed invention. For purposes of examination, it is assumed that the language is intended to mean that the protruding piece protrudes from a location along the thickness and any reference that shows the protruding piece protruding from any infinite number of locations along the thickness makes the recitation unpatentable. An examination based on the merits, as best understood, is addressed below.
 - In reference to Claim(s) 6, lines 6 and 7, the recitation "the surface" lacks proper antecedent basis. For purposes of examination, it is assumed that the claim is intended to read as follows:

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said packing body includes a first contact portion being opposite to and in contact with said first article and a second contact portion being opposite to and in contact with said second article,

a [said] surface of one of said first contact portion and said second contact portion is formed flatly along a complimentary [said] surface one of said first article and said second article, and

a second surface of said other of said first contact portion and said second contact portion is formed to be tapered toward one of said first article and said second article.

An examination based on the merits, as best understood, is addressed below.

-- Appropriate response to the above is required.

Claim Rejections - 35 USC § 102

- The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

** Claim(s) 1,3, and 5-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Koumatsu et al. (5879178).

-- In reference to Claim(s) 1, Koumatsu shows (cover sheet)

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a solid-core ring-shaped packing body 4 having a thickness a first direction in which the first article and the second article face each other larger than a width in a second direction orthogonal to the first direction;

a protruding piece 4a which protrudes from a position where the thickness of the packing is divided into two segments;

a securing portion (see examiner's figure) attached to the protruding piece 4a and secured to the first article 1.

-- In reference to Claim(s) 3, Koumatsu shows (cover sheet)

the protruding piece 4a is a protruding piece which protrudes outwardly from an outer edge of the solid-core ring-shaped packing 4.

-- In reference to Claim(s) 5, Koumatsu shows (cover sheet)

the securing portion (see examiner's figure) is a securing piece which protrudes toward the first article 1 from the protruding piece 4a, and the securing piece is secured in a receiving hole (figures 3 and 4e) formed in the first article 1 so that the protruding piece is secured to the first article.

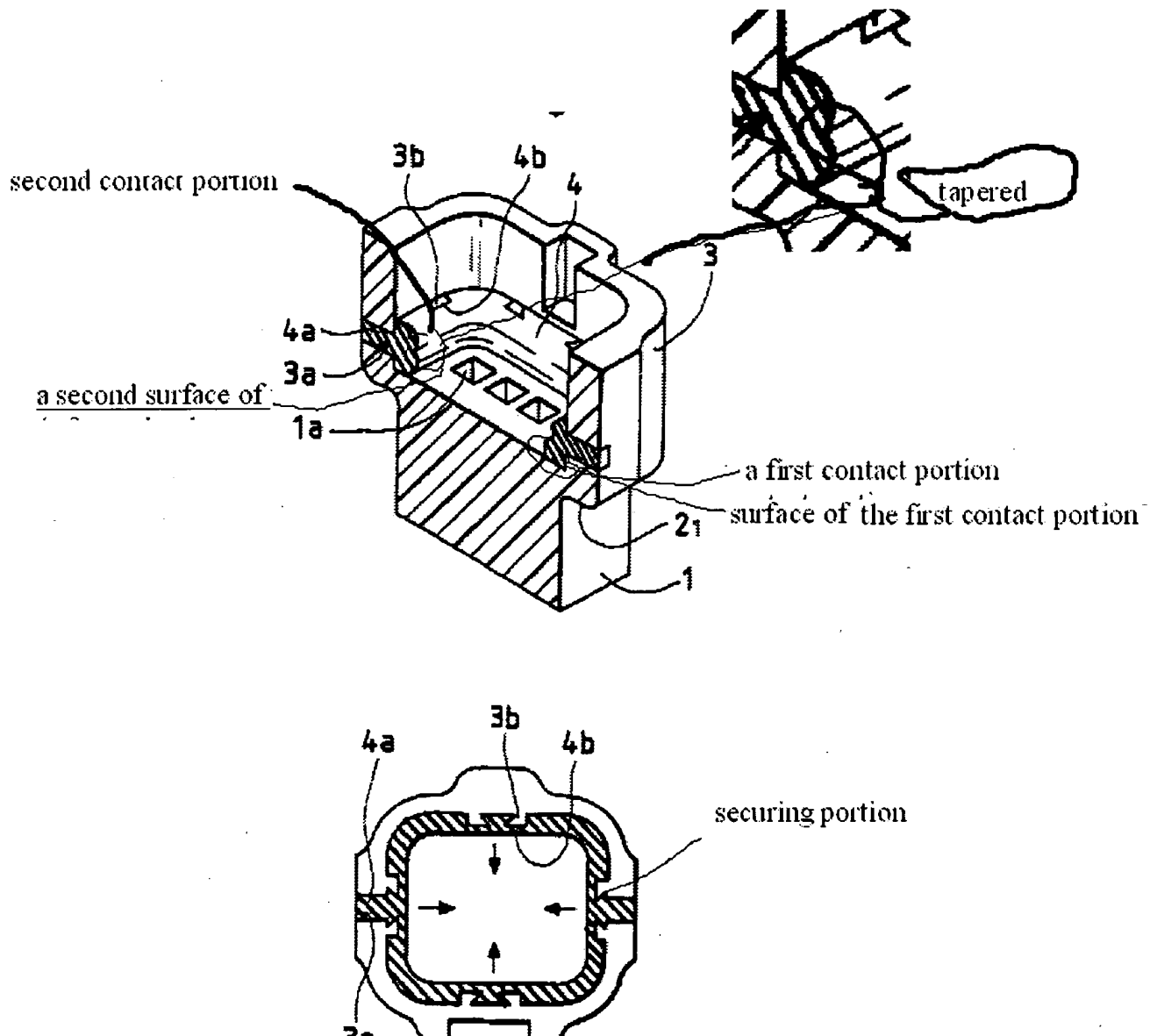
-- In reference to Claim(s) 6, Koumatsu shows (cover sheet)

the packing body includes a first contact portion (see examiner's figure) being opposite to and in contact with the first article 1 and a second contact portion (see examiner's figure) being opposite to and in contact with the second article (column 4, lines 1-12),

a surface (see examiner's figure) of the first contact portion is formed flatly along a complimentary surface the first article 1, and

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a second surface (see examiner's figure) of the second contact portion is formed to be tapered (see examiner's figure) toward the second article.



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-- In reference to Claim(s) 7, Koumatsu shows (cover sheet)

a connector housing 1 which serves as a first article, the connector housing being to be coupled with a supplementary connector housing (column 4, lines 11-13) which serves as a second article.

Claim Rejections - 35 USC § 103

• The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

** Claim(s) 1,2, and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nye et al. (2903626).

-- In reference to Claim(s) 1, Nye shows (cover sheet)

a solid-core ring-shaped packing body 44 (coll. 3, line 17 and (column 4, lines 52-54));
a protruding piece (see examiner's figure) which protrudes from a position along the thickness of the packing¹;

a securing portion (hole) attached to the protruding piece and secured to the first article
10.

¹ The protruding portion of Nye is seen to protrude along the thickness at many locations (T=0, T=T/2, and T=T).

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However, Nye does not explicitly show the solid-core ring-shaped packing body 44 having a thickness a first direction in which the first article and the second article face each other larger than a width in a second direction orthogonal to the first direction.

This recitation is seen to be a function of the size that is dependent upon the parameters that the customer desires (i.e. the greater the pressure requirement the greater the ratio of the thickness to width).

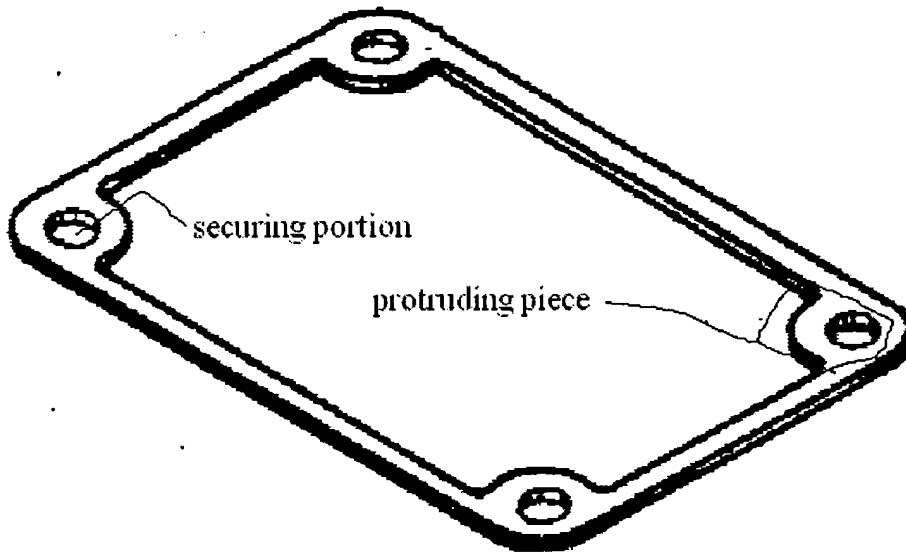
It would have been obvious to one of ordinary skill in the art at the time the invention was made to change the size of the width or thickness of the packing of Nye, since such a modification would have involved a mere change in the size. A change in size is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955). One skilled in the art would be motivated to change the size of the packing of Nye to meet the market demand for a particular size gasket that would seal at a higher pressure.

-- In reference to Claim(s) 2, Nye shows (see examiner's figure)

the protruding piece (see examiner's figure) is a protruding piece which protrudes inwardly from an inner edge the solid-core ring-shaped packing.

-- In reference to Claim(s) 4, Nye shows (see examiner's figure)

the securing portion is a hole which passes through the protruding piece and a protruding pin 13 protruding from the first article 10 is inserted in the hole so that the protruding piece is secured to the first article 10.



Conclusion

- The prior art listed on PTO form 892 that is made of record and not relied upon is considered pertinent to applicant's disclosure because it shows the state of the art with respect to applicant's claimed invention. In particular, DuRocher et al. shows a protruding piece 41 extending outwardly with mounting holes 42 and Heller shows a gasket C with protruding piece 30 extending inwardly.
- Any inquiry concerning this communication or earlier communications from the examiner should be directed to James R. Harvey whose telephone number is 571-272-2007. The examiner can normally be reached on 8:00 A.M. To 5:00 P.M.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula A. Bradley can be reached on 571-272-2800 extension 33.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-2800.

- Effective **October 1, 2003**, all patent application related correspondence transmitted by facsimile must be directed to the central facsimile number, **(703) 872-9306**, with a few exceptions. *See Fax Automation in Technology Center 1700*, 1237 *Off. Gaz. Pat. Office* 140 (August 29, 2000). Replies to Office actions including after-final amendments that are transmitted by facsimile must be directed to the central facsimile number. Unofficial correspondence such as draft proposed amendments for interviews may continue to be transmitted by facsimile to the Technology Centers.
- Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James R. Harvey, Examiner

jrh

November 29, 2004

